

**REMARKS/ARGUMENTS**

Reconsideration and allowance of this application are respectfully requested. Currently, claims 1-29 are pending in this application.

**Rejection Under 35 U.S.C. §101:**

Claims 10-20, 23 and 27-29 were rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The Office Action alleges that “Claim 10 appears to be a system (apparatus) of software alone, lacking the necessary physical components (hardware) to constitute a machine or a manufacture under 101.” Applicant respectfully disagrees with this allegation. Claim 10 is not directed to a system of software alone. For example, independent claim 10 explicitly requires “a generic process plan store” and “a non-generic process element store.” Claim 10 therefore explicitly requires physical components (hardware). Moreover, claim 10 further requires “means for searching” and “means for inserting content”, which are to be interpreted in view of corresponding structure recited in the specification and the equivalents thereof. Claim 10, and its dependents, are therefore clearly directed to statutory subject matter under 35 U.S.C. §101.

The apparatus of claim 10 is capable of generating a process plan and outputting the generated process plan. (see elements (iv) and (v) required by claim

10). The apparatus of claim 10 therefore produces a useful, concrete and tangible result.

Accordingly, Applicant respectfully requests that the rejection of claims 10-20, 23 and 27-29 under 35 U.S.C. §101 be withdrawn.

**Double Patenting Rejection:**

Claims 1-29 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-20 of co-pending application no. 09/739,317 in view of Ernst (U.S. '133).

Applicant respectfully traverses this rejection. The present application is an earlier filed parent application of application no. 09/739,317<sup>1</sup>. Applicant has filed a Response in later-filed application no. 09/739,317 including a terminal disclaimer disclaiming a terminal part of any patent granted in the present application. A terminal disclaimer has thus been filed in the later-filed application.

MPEP §1490 indicates that if a provisional obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of two pending applications, the Examiner should withdraw the rejection and permit the earlier-filed application to issue as a patent without a Terminal Disclaimer. As noted above, claims 10-20, 23 and 27-29 are in full conformance with 35 U.S.C. §101. Also, Applicant submits that the rejection of claims 1-29 under 35 U.S.C. §103 is unjustified for the reasons discussed below. Accordingly, Applicant

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<sup>1</sup> Application no. 09/739,317 is a continuation-in-part (CIP) of the present application.

submits that the only rejection remaining in the present application (i.e., the earlier filed application) is the ODP rejection. Since Applicant has filed a terminal disclaimer in the later-filed application, Applicant respectfully requests that the ODP rejection in the present application be withdrawn and permitted to issue as a patent without a terminal disclaimer.

**Rejection Under 35 U.S.C. §103**

Claims 1-29 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Jablonski (“On the Complementarity of Workflow Management and Business Process Modeling”, hereinafter “Jablonski”) in view of Schmidt et al. (“Extending Aspect-Oriented Programming In Order To Flexibly Support Workflows”, hereinafter “Schmidt”).<sup>2</sup> Applicant respectfully traverses this rejection.

In order to establish a *prima facie* case of obviousness, all of the claim limitation must be taught or suggested by the prior art. The combination of Jablonski and Schmidt fails to teach or suggest all of the claim limitations. For example, the combination fails to teach or suggest: “iii) searching said at least one generic process plan for the predetermined pattern contained by at least one non-generic process element, iv) on detection of the predetermined pattern, inserting

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<sup>2</sup> Corresponding text to this reference: Schmidt, R. & Assmann, U. “Extending Aspect-Oriented Programming In Order To Flexibly Support Workflows” In: Proceedings of the Aspect-Oriented Programming Workshop At ICSE '98 is cited in the concurrently filed information disclosure statement (IDS). That is, the “Schmidt” reference used in the rejection forms display material of a presentation which corresponds to this text – now cited in the concurrently filed IDS.

content from said at least one non-generic process element into the generic process plan to generate a process plan and v) outputting the generated process plan, wherein an instruction coded into each of the at least one non-generic process element determines how content is merged from the non-generic process element into the generic process plan at runtime of the generic process plan,” as required by independent claim 1 and its dependents. Similar (but necessarily identical) comments apply to independent claim 10 and its dependents.

Page 5 of the Office Action alleges that pages 36-37 of Jablonski disclose a generic process plan and a non-generic process element containing a predetermined pattern. Applicant respectfully disagrees with this characterization of Jablonski. In particular, pages 36-37 of Jablonski merely disclose activities that are nested structures (i.e., activities are composed of sub-activities). For example, Fig. 4 of Jablonski merely discloses that “travel claim processing” is a composite activity composed of three sub-activities: “submit travel claim”, “approve travel claim” and “reimburse client.” These sub-activities are elementary, i.e., they are not refined further. Pages 36-37 of Jablonski therefore fail to teach or suggest storing a generic process plan and a non-generic process element containing a predetermined pattern as alleged by the Office Action. Rather, pages 36-37 merely disclose a type of activity having a nested structure, and thus being composed of sub-activities.

Page 5 of the Office Action admits that Jablonski fails to teach or suggest:

“iii) searching said at least one generic process plan for the predetermined pattern contained by at least one non-generic process element, iv) on detection of the predetermined pattern, inserting content from said at least one non-generic process element into the generic process plan to generate a process plan and v) outputting the generated process plan, wherein an instruction coded into each of the at least one non-generic process element determines how content is merged from the non-generic process element into the generic process plan at runtime of the generic process plan.” Applicant submits that Schmidt fails to resolve this admitted deficiency of Jablonski.

Page 5, last paragraph, of the Office Action states “where the ‘Aspect weaver’ inserts the content of the ‘aspect implementations’ into the ‘workflow-specification’ to generate the (‘Workflow application’).” Since claim 1 requires “inserting content from said at least one non-generic process element into the generic process plan to generate a process plan,” Applicant assumes that the Office Action is alleging that Schmidt’s “aspect implementations” correspond to the claimed “non-generic process element”, Schmidt’s “workflow-specification” corresponds to the claimed “generic process plan”, and Schmidt’s “workflow application” corresponds to the claimed “generated process plan.” Clarification is respectfully requested if this is not the case.

Page 7 (specifically identified by the Office Action) of Schmidt discloses an aspect weaver receiving aspect implementations to produce a workflow application. However, page 7 clearly fails to disclose searching a generic process plan for a predetermined pattern contained by a non-generic process element and inserting content from the non-generic process element into the generic process plan on detection of the predetermined pattern. In particular, page 7 of Schmidt fails to disclose any generic process plan, let alone searching this generic process plan for a predetermined pattern. Schmidt's teaching of a workflow-specification fails to disclose a generic process plan, let alone searching this plan and inserting content from a non-generic process element when the search finds a predetermined pattern. Indeed, the workflow-specification illustrated on Fig. 7 is used to derive the aspect implementations, and therefore the workflow-specification is clearly not a generic process plan into which aspect implementations are inserted. The Office Action's characterization that content of the "aspect implementations" is inserted into the "workflow-specification" is erroneous. For example, there is no teaching or suggestion that Schmidt's aspect weaver receives the "workflow-specification" to enable the received "aspect implementations" to be inserted therein. Instead,

Schmidt's aspect weaver combines the aspect implementations to a workflow application.<sup>3</sup>

In short, there is no teaching or suggestion that Schmidt's aspect weaver receives a generic process plan so as to possibly insert content from the aspect implementations. Schmidt's aspect weaver also does not insert content from the aspect implementations into a generic process plan.

Schmidt's process attempts to resolve a problem in the design of systems that support running business processes, while the present invention is directed to generating (and altering via different inserted content) a process plan itself. Page 3 of the corresponding Schmidt text<sup>4</sup> states, "Workflow changes can be adopted much easier, because the aspects are dealt with separately. However, the whole software development cycle still has to be run through, because it is not possible to exchange parts of the workflow application, to represent changes in the workflow. Aspect-Oriented Programming maintains the separation of aspects until the aspect-weaver combines the different aspect implementations (emphasis added)." In contrast to Schmidt's process in which "it is not possible to exchange parts of the workflow application, to represent changes in the workflow" as noted above, the

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<sup>3</sup> See page 3 of Schmidt, R. & Assmann, U., "Extending Aspect-Oriented Programming In Order To Flexibly Support Workflows" In: Proceedings of the Aspect-Oriented Programming Workshop At ICSE '98 stating "The aspect specifications are the basis for the implementation aspect implementations. These implementations, which still are not compiled, are combined by the aspect weaver to an workflow specification."

<sup>4</sup> Schmidt, R. & Assmann, U., "Extending Aspect-Oriented Programming In Order To Flexibly Support Workflows" In: Proceedings of the Aspect-Oriented Programming Workshop At ICSE '98 – cited in the concurrently filed Information Disclosure Statement

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present invention is precisely designed and implemented to allow this. Schmidt thus teaches away from the present invention.

Accordingly, even if the teachings of Jablonski and Schmidt were combined as proposed by the Office Action, the combination would not have been taught or suggested all the claim limitations. Accordingly, Applicant respectfully requests the rejection of claims 1-29 under 35 U.S.C. §103 over Jablonski and Schmidt be withdrawn.

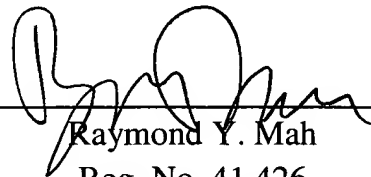
**Conclusion:**

Applicant believes that this entire application is in condition for allowance and respectfully requests a notice to this effect. If the Examiner has any questions or believes that an interview would further prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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